

### REMARKS

Applicant respectfully requests reconsideration. Claims 1-26 were previously pending in this application. By this amendment, Applicant is canceling claim 1 without prejudice or disclaimer. Claims 2, 4, 6, 8, 10 and 12-18 have been amended. Specifically, claim 2 has been rewritten in independent form and claims 4, 6, 8, 10 and 12-18 have been amended to depend from claim 2. New claims 27-30 have been added. As a result, claims 2-30 are pending for examination with claims 2, 19 and 26 being independent claims. No new matter has been added.

#### Rejections Under 35 U.S.C. §103

Claims 2-9, 11, 12, 21 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rogers, further in view of Aearo Company ([www.earsc.com](http://www.earsc.com)).

#### Claim 2

Claim 2 (which was rewritten in independent form to include all the limitations of claim 1) is directed to a guard for protecting a leg of a horse including, *inter alia*, a layer of foam having a ball rebound value of about 3% or less and an attachment device permitting attachment of the guard about a leg of a horse.

As the Office Action stated, having a ball rebound of less than about 3% is a characteristic of the Aearo Company's CONFOR® foam, a slow-recovery, non-resilient foam. The Office Action further states that Rogers discloses a protective guard for the leg of a horse comprising layers 42, 44, and 46 of viscoelastic, open-cell, polyurethane foam that is covered by an outer shell of protective fabric. (Applicant disputes that Rogers teaches an open-cell, viscoelastic foam.) As the Office Action concedes in paragraph 4, Rogers states that a preferable foam would exhibit pliable, soft and resilient characteristics that would protect the horse's leg from injury.

The Office Action also states that the Aearo Company ("Aearo Reference") discloses a variety of urethane foams, such as the CONFOR® foam, "that are ideal for comfort management and protective padding applications," because of, "their high energy-absorption characteristics." (Aearo, p.1, ¶ 1). The Office Action concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rogers' guard by using the

Aearo Reference's urethane foam, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 U.S.P.Q. 416. Applicant respectfully traverses this rejection.

One of ordinary skill would not have selected the urethane foam of the Aero reference based upon the teaching of Rogers, because such a substitution of the CONFOR® foam into the legging of Rogers would change the principle of operation of Rogers. See M.P.E.P. § 2143.01 ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.").

Rogers discloses a device for shielding a horse's leg from insect bites including a fly netting 40 attached to a rim 30 and columns 42, 44, and 46. "Rim 30 and columns 42, 44, and 46 are fabricated from a resilient material...which retains its shape." (Rogers, col. 3, lines 23-25 (emphasis added)). Columns 42, 44, and 46 must "[have] a thickness sufficient to hold the netting 40 off the horse's leg" and "provide vertical rigidity to legging 20 preventing it from drooping or otherwise collapsing." (Rogers, col. 4, lines 28-29; col. 3, lines 17-18). The rim and columns "hold the fly netting away from the lower leg" thereby "[spacing] the netting from the leg so that horse flies cannot bite the leg." (Rogers, col. 2, lines 5-6; Abstract, lines 7-9). Rogers specifies that "[if] netting 40 were not spaced from leg 700, a horse fly could still bite through the holes in the netting 40. Additionally the spacing of the netting increases air circulation, thereby keeping legging 20 and the leg cooler and drier." (Rogers, col. 4, lines 37-40).

Rogers describes the rim 30 and columns 42, 44 and 46 as being made from a 'resilient' material. As is known by one of ordinary skill in the art, 'resilient' refers to a 'quick-recovery' foam. As can be seen in the attached printout from the Aearo Company's website (the same Aearo Company from which the Aearo Reference was obtained), [www.earsc.com/pdfs/engineering/specifyingcushioning.pdf](http://www.earsc.com/pdfs/engineering/specifyingcushioning.pdf) (hereinafter "Aearo Website"), there are two categories of foams: quick-recovery and slow-recovery. A quick-recovery foam is resilient and will thereby recover from a compression load quickly and not maintain an impression from the load. That is the type of foam specified by Rogers. A slow-recovery foam is one that conforms to a compression load as the slow-recovery foam does not return to its original shape quickly, but will instead, retain the impression of the compression load for much

longer than a resilient, quick-recovery foam. That is the type of foam recited in claim 2. These two foams function very differently and produce a very different result.

In contrast to the resilient foam required by Rogers, the Aearo Website specifically states that CONFOR® foam is a slow-recovery material and is not resilient. The non-resilient CONFOR® foam is described by the Aearo Website as having low rebound properties. As noted in paragraph 4 of the Office Action, Aearo's foams exhibit ball rebound values of at least between 1-2.8%. Such a low ball rebound foam would not maintain the spacing required by Rogers to prevent insect bites and allow ventilation and which is provided by rim 30 and columns 42, 44 and 46. In contrast, as can be seen in the Aearo Website, for example, in the bar graph entitled, "Brief Primer for Selecting Cushing Materials" on page 4, a resilient foam, such as that which is specified by Rogers, has much higher rebound properties. Such a high ball rebound foam would maintain the spacing required by Rogers.

Therefore, it would not have been obvious to use the low rebound CONFOR® foam having ball rebound values of less than 3% in Rogers' legging, which requires a resilient foam, which is a high rebound foam. In fact, the teaching of Rogers would actually lead one of skill away from the low rebound CONFOR® foam. One would only select such a low rebound foam as recited in claim 2 based on hindsight gained from Applicant's teachings. Accordingly, use of foam having ball rebound values of less than 3% would have been unobvious in light of Rogers, and withdrawal of the rejection of claim 2 is respectfully requested.

#### Claim 26

Independent claim 26 is directed to a method of protecting an area on a leg of a horse including, *inter alia*, wrapping about the area to be protected a layer of open-cell, viscoelastic foam having low rebound properties and high energy absorption properties, allowing the layer of foam to conform to the shape of the leg of the horse, and attaching one portion of the layer of foam to another to secure the layer of foam about the leg of the horse.

As noted with respect to claim 2, Rogers teaches away from the use of low rebound foams. Moreover, claim 26 also is patentable because the proposed modification to the device of Rogers would have rendered Rogers' device unsatisfactory for its intended purpose. See

M.P.E.P. § 2143.01 (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”). As quoted above from Rogers, the effectiveness of Rogers’ legging depends upon the fact that the foam spaces the netting from the horse’s leg. Claim 26 recites that the layer of foam is allowed to conform to the shape of the leg. The use of a conformable foam, like CONFOR®, would allow the netting to touch or be proximate enough to the horse’s leg that insects could bite the horse and that ventilation would be reduced, thereby rendering the legging unsatisfactory for its intended purpose.

Therefore, it is respectfully submitted that the Office Action fails to set forth a *prima facie* case of obviousness because using the foam of the Aearo reference in Rogers’ legging in the manner suggested would change the principle of operation of Rogers’ legging and would render the resulting device unsatisfactory for its intended purpose. That is, since low rebound foams are not resilient, using a low ball rebound foam in Rogers’ legging would change the principle of operation of Rogers’ legging and using a foam that conforms to the shape of the leg of the horse would not allow for sufficient space between the netting and the horse’s leg for Rogers’ legging to protect the leg from insect bites and allow ventilation. Accordingly, it is requested that the rejection of claim 26 under §103(a) as being unpatentable over Rogers in view of the Aearo reference be withdrawn.

#### Claims 3 and 21

Dependent claim 3 is directed to a guard for protecting a leg of a horse including, *inter alia*, a layer of foam having a ball rebound value of between 1% and 3%. Dependent claim 21 is directed to a guard for protecting a leg of a horse including, *inter alia*, a layer of material having low rebound properties.

As discussed above with respect to claim 2, having a ball rebound of between 1% and 3% and having low rebound properties are characteristics of the Aearo Company’s CONFOR® foam, a slow-recovery, non-resilient foam. Since Rogers requires a resilient foam, as noted in the Office Action, the proposed insertion of the CONFOR® foam into the device of Rogers would not be suitable for the intended use and would change the principle of operation, thereby rendering such a substitution unobvious.

Accordingly, and in addition to the fact that claims 3 and 21 depend respectively from claims 2 and 19 and are patentable for at least the same reasons, it is requested that the rejections of claims 3 and 21 under §103(a) as being unpatentable over Rogers in view of the Aearo reference be withdrawn.

Claims 4-9, 11 and 12

Without acceding to the propriety of the rejections, claims 4-9, 11 and 12 depend from independent claim 2 and are patentable for at least the same reasons as claim 2.

Accordingly, withdrawal of these rejections is respectfully requested.

Rejections Under 35 U.S.C. §102

Claims 1, 10, 13-20, and 22-25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Rogers (U.S. Patent No. 6,151,873). Without acceding to the propriety of the rejection, claim 1 has been cancelled, as noted above. Applicant respectfully traverses the rejections of claims 10, 13-20 and 22-25.

Claims 19-20 and 22-25

Independent claim 19 is directed to a guard for protecting a leg of a horse including, *inter alia*, an outer shell, an attachment device, and a layer of material disposed within the shell that is conformable to a shape of the horse's leg at a body temperature of a horse, the layer of material having high energy absorption properties.

Applicant submits that Rogers simply does not teach using a layer of material that is conformable to a shape of the horse's leg. Moreover, the Office Action did not specifically identify any such teachings.

Not only does Rogers not teach using a conformable material, conformability would not have been an inherent characteristic of the foam taught to be used in Rogers' legging. As the Office Action points out, Rogers describes his foam as having 'resilient' characteristics. As explained above, a 'resilient' foam is a 'quick-recovery' high rebound foam and would not be conformable.

Further, it would not have been obvious to use a material that is conformable to the shape of a horse's leg in the rim and columns of Rogers' legging, because Rogers teaches away from using a conformable material, as discussed above. The rim and columns of Rogers employ a 'resilient' foam in order to hold the netting away from the horse's leg. As explained above, a 'resilient' foam is a 'quick-recovery' foam. A quick-recovery foam will recover from a compression load quickly and not maintain an impression from the load. On the other hand, conformable foam conforms to a compression load and does not return to its original shape quickly, but will instead, retain the impression of the compression load for much longer than a resilient, quick-recovery foam. If a material that is conformable to the shape of the horse's leg were to be used in Rogers, the netting of Rogers would become more proximate the horse's leg, thereby severely narrowing or even closing the protective space between the horse's leg and the netting. This would allow insect bites and prevent ventilation, contrary to the purpose of the Rogers legging.

Rogers does not teach or inherently disclose using a layer of material that is conformable to a shape of the horse's leg. Rogers actually teaches away from such a material. Thus, independent claim 19 patentably distinguishes over Rogers, and it is requested that the rejection under §102(b) be withdrawn. Claims 20-25 depend from independent claim 19 and are patentable for at least the same reasons.

#### Claims 10 and 13-18

Without acceding to the propriety of the rejections, claims 10 and 13-18 each depend from independent claim 2 and are patentable for at least the same reasons.

Accordingly, withdrawal of these rejections is respectfully requested.

#### New Claims

New dependent claims 27-30 have been added.

Support for new claim 27 may be found, for example, in the specification on page 8, lines 1-6. Claim 27 depends from independent claim 1 and is allowable for at least the same reasons. In addition, as discussed with respect to independent claim 19, Rogers does not teach or suggest and actually teaches away from using a layer of foam that conforms to a shape of the horse's leg.

Support for new claims 28-30 may be found, for example, in the specification on page 9, line 27 and on page 12, lines 18-24. Claims 28-30 depend from independent claim 26 and are allowable for at least the same reasons. In addition, Rogers does not teach or suggest an outer shell that is more rigid than the foam. The outer shell of Rogers is the fly netting 40 and, as is known in the art, fly netting is very flexible and would be less rigid than the 'rigid' vertical columns 42, 44 and 46 of Rogers. Thus, Rogers does not teach or suggest an outer shell that is more rigid than the layer of foam.

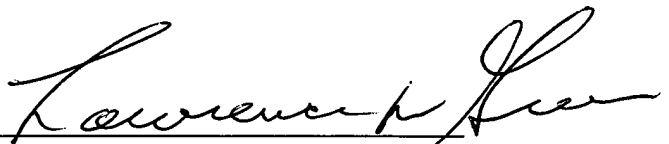
### CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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Date: January 5, 2005  
x01/05/05